

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants : Van Barlow et al.
Serial No. : 10/017,746
Filed : December 7, 2001
For : COATED STAPLE AND FASTENING TOOL FOR THE SAME
Examiner : Lopez, Michelle
Art Unit : 3721
Attorney
Docket No. : 510P004
Confirmation
No. : 8798
Customer No. : 42754

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

LETTER OF TRANSMITTAL

There are filed herewith (3) copies of Appellant's Brief on Appeal in the above-identified case.

The due date of Appellant's Brief was two months from the date of receipt (November 26, 2005) by the PTO Appellant's Notice of Appeal: namely January 26, 2005. This due date is now extended by two month so as to expire March 26, 2005 by virtue of the petition for extension of time filed herewith, together with the applicable extension fee.

A check in the amount of \$250.00 in payment of the Brief on Appeal fee is enclosed herewith.


The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 14-0930.

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Signature: Kevin S. Lemack

Date: March 24, 2005

Respectfully submitted,


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Appeal No. :

-BRIEF ON APPEAL-

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants : Van Barlow, et al.
Serial No. : 10/017,746
Filed : December 7, 2001
For : COATED STAPLE AND FASTENING TOOL FOR THE
SAME
Examiner : Lopez, Michelle
Art Unit : 3721
Confirmation
No: : 8798
Customer No. : 42754
Docket No. : 510P004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF

The Appellants hereby submit this brief, in triplicate, in support of the Appellants' appeal from the decision of the Examiner dated May 27, 2004 rejecting claims 1-15.

A check in the amount of \$340.00 for the fee for filing a brief in support of an appeal pursuant to 37 C.F.R. §1.17(f) is enclosed, along with a petition and check in the amount of \$110.00 for a one-month extension of time.

I. REAL PARTY IN INTEREST

As the assignee of the entire right, title and interest in the inventions and improvements which are the subject of this application, Acme Staple Company, Inc., having a place of business at 87 Hill Road, West Franklin, New Hampshire, is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

To the best of the Appellants' knowledge, no other appeals or interferences are pending which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-15 are pending in the subject application.

Claims 1-15 stand rejected.

IV. STATUS OF AMENDMENTS

No amendments to the claims were filed subsequent to the final rejection dated May 27, 2004.

V. SUMMARY OF INVENTION

A fastening tool and fasteners for fastening an object to a substrate (page 3, lines 14-15), as well as an insulated staple for securing a wire to a substrate (Page 7, lines 6-7), a method of fastening an article to a substrate (page 10, lines

15-26), and a method of forming an insulated staple (page 7, line 5 to page 9, line 22). The fastening tool includes a housing (page 4, lines 15-18), a driver that moves reciprocally in a drive path in the housing and an actuator for actuating the driver (page 4, line 18 to page 5, line 7), a magazine assembly (page 5, line 13-15) containing one or more individually uniformly coated fasteners, each forming a unitary structure with the coating (page 7, line 25 to page 9, line 15), and a pusher (page 5, lines 13-15). The insulated staple includes a dielectric coating uniformly coated on the staple body and adhering to the bight portion and pair of legs of the staple so as to form an integral unitary structure (page 7, line 25 to page 9, line 26). The method of fastening an article to a substrate involves providing the above fastening tool with a magazine assembly containing one or more of the above coated fasteners, positioning tool about the article to be fastened, actuating the driver to propel the forwardmost coated fastener out of the tool housing and into a substrate about the article (page 10, lines 15-26). The method of forming an insulated staple involves providing a staple body adapted to be formed into a bight portion and a pair of legs (page 7, lines 6-24), providing a uniform coating on the staple body with a dielectric coating prior to formation into the bight portion and pair of legs (page 9, lines 15-17), and

forming the staple body into the bight portion and pair of legs so as to form an integral unitary structure.

VI. ISSUES

Whether claim 15 is anticipated by Kish '405, U.S. Patent No. 5,882,405.

Whether claims 1-10 and 13-14 are unpatentable under 35 U.S.C. §103(a) over the combined teachings of Dennis, U.S. Patent No. 6,082,604 and Kish, U.S. Patent No. 5,882,405.

Whether claims 11-12 are unpatentable under 35 U.S.C. §103(a) over the combined teachings of Dennis, U.S. Patent No. 6,082,604 and Kish, U.S. Patent No. 5,882,405, and further in view of Kish, U.S. Patent No. 5,441,373.

VII. GROUPING OF CLAIMS

The dependent claims stand or fall with the claims on which they depend.

VIII. ARGUMENTS

1. Claim 15 is not anticipated by Kish '405

The Examiner states that Kish '405 discloses a method of forming an insulated stapled including the process steps of providing a staple body via wire 12 adapted to be formed into a bight portion and a pair of legs, uniformly coating the staple body with a dielectric coating prior to formation into the

bight portion and pair of legs, and forming the staple body into the bight portion and the pair of legs to form an integral unitary structure. The Examiner cites Figures 9-13 of Kish '405 where the process step of feeding individual and separated wires "12" to a coating station "14" is shown, and concludes that the fasteners are formed from a staple body or wire "12" being individually and uniformly coated, thereby forming a unitary structure as between each individual fastener and the coating.

Appellant respectfully disagrees.

A claim is anticipated only if each and every element set forth in the claim is found in a single prior art reference. *Verdegaal Bros.v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Appellants submit that the identical invention of claim 15 is not shown or even suggested by Kish '405, for the following reasons.

A key feature of the fasteners of the present invention as recited in claim 15 is the integral unitary structure comprised of the staple and its coating. The term "unitary structure" is used to indicate that an individual staple and its coating constitute a complete, separate and distinct structure, and that the unitary structure of one staple and its coating does not interfere with adjacent unitary coated staple structures. Indeed, even when cohered **cores** of staples are created, the coherence is created with glue, not with the coating.

In the instant invention, a dielectric coating is applied to wire, and then formed into a staple. The steps, separated in time, of applying the coating and then forming the coated wire into a staple, allow each staple and its coating to form the requisite integral, unitary structure, such that the coating of one staple cannot blend or meld with the coatings of adjacent staples. The coating, therefore, does not and cannot participate in forming **cores** of staples.

Kish '405 teaches the opposite, as it is an express object of Kish '405 to use the coating to cohere the staples together:

"This invention relates generally to coated fasteners, and more particularly to a method and apparatus for providing a continuous in-line process for mass-producing coated fasteners, such as staples or nails, **arranged in a strip or block** for ease of handling and packaging as well as loading into a driving tool. . . . The coating protects the fastener against corrosion, **adheres successive fasteners together into a strip or block** and provides improved retention of the fastener when driven into a desired surface." (Column 1, lines 14-25, emphasis added).

Thus, in Kish '405, the coating is cured in such a way that allows the coating to flow about the exterior surfaces of the wires and adhere the wires together into a continuous band. Accordingly, an integral unitary structure is not and cannot be formed between each individual staple and its coating; instead, a unitary coated band is formed.

The Examiner cites column 6, lines 34-36 and 62-65 in support of her position. These passages recite that separating rollers are used to separate the wires to enable coating of the entire exterior surfaces of the wires. However, the Examiner

fails to cite and consider the subsequent paragraph, namely, column 6, line 66 to column 7, line 5, which expressly states that, after coating, the wires are collated or merged back together to form a band of wires. This merging is carried out before the coating is cured, as evidenced by column 7, lines 14-22, which teach how to remove excess coating that accumulates on the merging rollers. No such coating could accumulate on the merging rollers if the coating had already cured prior to the wires being merged. Moreover, it is the express object of Kish '405 to use the coating itself to adhere the merged wires together, as stated above. This adhesion could not be achieved if each staple and its coating constituted a distinct, integral and unitary structure.

Accordingly, Kish '405 nowhere discloses or suggests providing a uniform coating on a staple body and forming the staple body into a bight portion and a pair of legs where the coating adheres to the bight portion and pair of legs after formation so as to form an integral unitary structure.

The integral unitary structure of staple and coating is important in the application contemplated by the present invention (ie, affixing electrical wire to a substrate). The integral unitary structure taught insures that there is a consistent amount of dielectric coating on each staple, leading to uniformity of insulating and/or cushioning properties from staple to staple.

2. Claims 1-10 and 13-14 are not obvious over Dennis in view of Kish '405, and claims 11-12 are not obvious over

Dennis in view of Kish '405, and further in view of Kish '373.

A. The references do not teach or suggest all the claim limitations, and in fact teach away from the claimed invention.

To establish a *prima facie* case of obviousness, the prior art must teach or suggest all the limitations of a claim, there must exist a suggestion or motivation in the references themselves or as a matter of general knowledge to modify or combine the references, and there must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). However, the Examiner may not establish obviousness using hindsight or in view of the teachings or suggestions of the Appellants. *Para-Ordnance Manufacturing, Inc. v. SGS Importers International, Inc.*, 73 F.3d 1085, 37 U.S.P.Q.2d 1237 (Fed. Cir. 1995). "To draw on hindsight knowledge of the...invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction--an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 38 U.S.P.Q.2d 1551 (Fed. Cir. 1996). All limitations of a claim must be taught or suggested by the cited references to establish *prima facie* obviousness. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Appellant does not dispute that the teachings of Dennis '604 relate to a fastening tool that includes a housing, a

driver, an actuator, a magazine, a pusher and a process for fastening a wire to a substrate. However, as described above in Section VIII(1), Appellant vigorously disputes that the teachings of Kish '405 show or suggest individual uniformly coated fasteners where each individual fastener forms a unitary structure with its coating.

As noted in Section VIII(1) above, the Examiner cites Figures 9-13 of Kish '405 in support of her position. Applicants agree that Figures 9-13 of Kish '405 show individual and separated wires 12 being fed to a coating station 14 where the staple bodies are individually coated. However, Kish '405 teaches in reference to Figure 13 that the wires are formed into bands by merging rollers, and that during use, the merging rollers can accumulate excess coating on their surfaces. Such excess coating and the concomitant need to remove it with a scraper blade 64 would not be present were the coating already cured. Instead, the coating is not yet cured and is used to adhere the wires together, see column 5, lines 50-57:

"After heating, the wires 12 are conveyed into the cooling chamber 20 where they preferably are water cooled, but curing with air or any other gas can be provided. When the wires 12, which are arranged substantially parallel in successive side-by-side engagement, are adhered together laterally by the coating alone to form a continuous band of wires as illustrated in FIG. 3." (Emphasis added.)

Accordingly, an integral unitary structure of each individual fastener and its coating is not and cannot be formed by Kish '405. Kish '405 teaches away from doing so by using the coating alone to adhere a plurality of wires together.

With respect to claims 11-12, Kish '373 is cited for its disclosure of a staple made of steel, and does not provide the deficiencies of Kish '405 set forth above.

IX. CONCLUSION

For the reasons set forth above, the Appellant requests that the Examiner's rejections of claims 1-15 be reversed and that all pending claims be allowed.

Respectfully submitted,



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APPENDIX
CLAIMS ON APPEAL

1. A fastening tool and fasteners for fastening an object to a substrate,
said tool comprising:

a housing;

a driver mounted in said housing for reciprocal movement in a drive path;

an actuator for actuating said driver;

a magazine assembly associated with said housing, said magazine assembly containing one or more individual uniformly coated fasteners, including a forwardmost fastener, each individual fastener forming a unitary structure with said coating, said magazine assembly having a nose end and a tail end spaced from said nose end;

a pusher in said magazine assembly for urging said plurality of fasteners towards said nose end such that said forwardmost fastener is aligned in said drive path.

2. The fastening tool and fasteners of claim 1, wherein said coating on said fasteners is electrically insulating.

3. The fastening tool and fasteners of claim 1, wherein said coating on said fasteners has cushioning properties.

4. The fastening tool and fasteners of claim 1, wherein said one or more fasteners are staples.
5. The fastening tool and fasteners of claim 1, wherein said coating is selected from the group consisting of nylon, polyethylene, polypropylene, polybutylene, PVC, CPVC, ABS and PVDF.
6. The fastening tool and fasteners of claim 1, wherein said coating is nylon.
7. The fastening tool and fasteners of claim 1, wherein said magazine assembly is detachably secured to said housing.
8. An insulated staple for securing a wire to a substrate, comprising:
a staple body formed into a bight portion; and a pair of legs extending from said bight portion, each leg terminating in a free end; and
a dielectric coating uniformly coated on said staple body prior to formation into said bight portion and said pair of legs, said coating adhering to said bight portion and pair of legs after formation into said bight portion and pair of legs so as to form an integral unitary structure.
9. The insulated staple of claim 8, wherein said coating remains stationary on said staple.

10. The insulated staple of claim 8, wherein said coating has a thickness of from about 0.001 inches to about 0.050 inches.

11. The insulated staple of claim 8, wherein said staple is made of bright or galvanized steel.

12. The insulated staple of claim 8, wherein each said free end terminates in an angled cut to facilitate penetration into said substrate.

13. A method of fastening an article to a substrate, comprising the steps of:

a) providing a fastening tool comprising;

a housing;

a driver mounted in said housing for reciprocal movement in a drive path;

a magazine assembly associated with said housing, said magazine assembly containing one or more individual uniformly coated fasteners, including a forwardmost fastener, each individual fastener forming a unitary structure with said coating, said magazine assembly having a nose end and a tail end spaced from said nose end; and

b) properly positioning said fastening tool about said article to be fastened; and

c) actuating said driver thereby causing said driver to strike said forwardmost coated fastener and propel said forwardmost coated fastener out of said housing and into said substrate about said article.

14. The fastening tool and fasteners of claim 1, wherein said object to be fastened is selected from the group consisting of wire, cable and tubing.

15. A method for forming an insulated staple for securing a wire to a substrate, comprising:

providing a staple body adapted to be formed into a bight portion and a pair of legs extending from said bight portion, each leg terminating in a free end;

providing a uniform coating on said staple body with a dielectric coating prior to formation into said bight portion and said pair of legs;

forming said staple body into said bight portion and pair of legs, said coating adhering to said bight portion and said pair of legs after formation into said bight portion and pair of legs so as to form an integral unitary structure.